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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BIOMIRA INC.,

Opposer,

v.

BIOMARIN PHARMACEUTICAL INC.,

Applicant.

)
) Opposition No. 157,636

)
) Mark: BIOMARIN

)
) Serial No. 76/240,537

)
) Published: April 1, 2003



03-26-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

MOTION FOR LEAVE TO TAKE FOREIGN DEPOSITION ORALLY

Biomarin Pharmaceutical Inc. moves for leave to take the 30(b)(6) discovery deposition of the opposer by oral examination in Canada. Because there is good cause for the motion, it can and should be granted pursuant to TBMP 520.

Background

On March 1, 2004, Biomira noticed the discovery deposition of Biomira pursuant to Fed.R.Civ.P. 30(b)(6). A copy of the notice is attached as exhibit A. No other discovery depositions of Biomira or any of its personnel or customers were taken or are currently scheduled. Biomira has not, to date, identified its 30(b)(6) representative (or where that representative resides), but has taken the position that, because Biomira is a Canadian company, the deposition must take place in Canada. Assuming that rule 30(b)(6) does not require Biomira to designate a representative that is available in the U.S. (someone such as its domestic representative), this motion is required under 37 CFR 2.120(c)(1) in order to allow the deposition to proceed by oral examination.

Analysis

37 CFR 1.120(c)(1) provides that motions like this should be granted for good cause. TBMP 520 says, "In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country." In *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989), good cause existed where the deposition was the only deposition of one of the parties, the cost of lawyer travel to the deposition site in England was not significantly greater than the cost of travel within the U.S., and the oral deposition would not involve a foreign language.


There is equally good cause here. While Biomarin has had written discovery from Biomira, written discovery is of limited value in cases that are based on an ITU application covering a mark that is not yet in use in U.S. commerce. This is such a case: Biomira's opposition is based, in part, on an ITU application that is now in its final extension period for filing a statement of use. With the mark not yet in use, the likelihood of confusion issue in this case may depend on what channels of trade will be used when and if Biomira commences use of the mark in the U.S. Facts about potential or likely future use are particularly difficult to discover through written discovery. Consequently, the deposition of Biomira's 30(b)(6) representative is Biomarin's best potential source of useful information about many of the important factual issues in this case. In addition, the cost of travel to Canada is even less than the cost of travel to Europe, and language should be no obstacle to a deposition in Canada. Since Biomira is the plaintiff in this case, it is not inequitable for it to have the obligation of providing at least one oral deposition.

Accordingly, this motion should be granted, and Biomarin should be given leave to take the noticed 30(b)(6) deposition by oral examination. If necessary, the discovery period should reopened or extended solely to accommodate the deposition¹.

Respectfully submitted,

BIOMARIN PHARMACEUTICAL INC.

Dated: March 23, 2004


Richard M. LaBarge
Attorney for Applicant

MARSHALL, GERSTEIN & BORUN LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606
(312) 474-6300 (telephone)

¹ The deposition was originally scheduled for March 18, 2004, and the discovery period is scheduled to close on March 24, 2004. To facilitate settlement discussions, Biomarin had proposed a thirty-day “standstill” agreement on outstanding discovery obligations. Biomira appears to have agreed. Ex. B.

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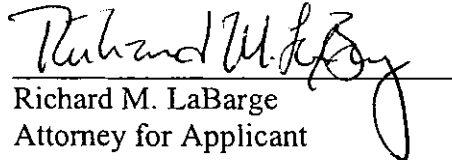
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Respectfully submitted,

BIOMARIN PHARMACEUTICAL INC.


Richard M. LaBarge
Attorney for Applicant

Dated: March 23, 2004

MARSHALL, GERSTEIN & BORUN LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606
(312) 474-6300 (telephone)

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BIOMARIN PHARMACEUTICAL INC.,)	Serial No. 76/240,537
)	
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)	

NOTICE OF DEPOSITION OF BIOMIRA, INC.

TO: Mark E. Ungerman, Esq.
FULBRIGHT & JAWORSKI L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

PLEASE TAKE NOTICE that commencing at 9:30 a.m. on Thursday, March 18, 2004, at your offices (or such other time as the parties may agree), Biomarin will take the deposition upon oral examination of Biomira, Inc. upon the matters listed in the attached schedule.

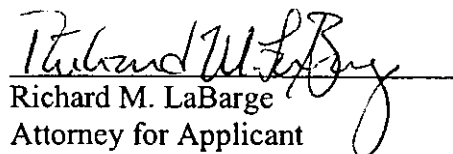
The company's designated representative is requested to bring whatever documents may be reasonably necessary to enable him or her to provide testimony on the matters identified.

The deposition will proceed in accordance with the Fed.R.Civ.P. 30(b)(6), and will be recorded by stenographic means before an officer authorized to administer oaths. You are invited to attend and cross-examine.

BIOMARIN PHARMACEUTICAL INC.

Dated: March 1, 2004

By:


Richard M. LaBarge
Attorney for Applicant

MARSHALL, GERSTEIN & BORUN LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606
(312) 474-6300 (telephone)
(312) 474-0448 (facsimile)

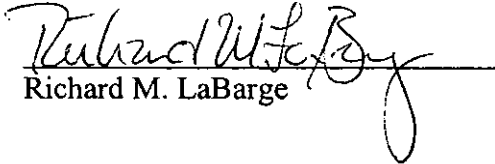
Schedule of topics

- 1) The substance of Biomira's responses to the interrogatories, documents requests, and requests for admissions in this case.
- 2) The history and extent of use of "BIOMIRA" in the U.S., specifically including the identity of the labels, packaging, and similar materials upon which "Biomira" has been used in the U.S., the timeframe when those materials have been used in the U.S., and the people or entities in the U.S. to whom those materials were distributed or presented.
- 3) All other uses or promotion of "BIOMIRA" that Biomira contends established protectable rights in its mark and/or name in the U.S.
- 4) The identity of potential purchasers or users in the U.S. of 1) pharmaceutical preparations used in the diagnosis and treatment of cancer, 2) pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer, 3) vaccines for prophylactic use, and 4) *in vivo* medical diagnostic kits comprised primarily of reagents.
- 5) The channels of trade through which 1) pharmaceutical preparations used in the diagnosis and treatment of cancer, 2) pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer, 3) vaccines for prophylactic use, and 4) *in vivo* medical diagnostic kits comprised primarily of reagents are generally promoted, distributed, and sold in the U.S.
- 6) The normal U.S. retail cost of 1) pharmaceutical preparations used in the diagnosis and treatment of cancer, 2) pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer, 3) vaccines for prophylactic use, and 4) *in vivo* medical diagnostic kits comprised primarily of reagents, the channels of trade through which such goods are generally advertised, distributed, and sold in the U.S., and the degree of care generally exercised by U.S. purchasers of such goods.
- 7) The identity of potential customers or users in the U.S. of the services recited in Biomira's application for U.S. trademark registration.
- 8) The normal terms and range of cost in the U.S. for the services recited in Biomira's application for U.S. trademark registration, the advertising channels through which such services are generally advertised in the U.S., and the degree of care generally exercised by U.S. purchasers of such services.
- 9) Known third-party uses of marks in the pharmaceutical field that include a term that begins with "Bio-", and customer perceptions of such uses.
- 10) The details of all instances of alleged confusion regarding the marks at issue.
- 11) The prevalence and possible causes of 1) "confusion" that occurs at conferences like the 2003 BIO CEO & Investor Conference with respect to timing and scheduling of meetings, 2) errors in links on conference websites, and 3) errors in the identification or spelling of corporate affiliations of speakers in speakers lists distributed at or in anticipation of such conferences.

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was served on Biomira on March 1, 2004 by forwarding copies by facsimile transmission and by regular mail to:

Mark E. Ungerman, Esq.
FULBRIGHT & JAWORSKI L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
FAX: (202) 662-4643


Richard M. LaBarge

FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP
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TELEPHONE: (202) 662-0200
FACSIMILE: (202) 662-4643

March 11, 2004

**VIA FACSIMILE
CONFIRMATION VIA FIRST CLASS MAIL**

Richard M. LaBarge
Marshall, Gerstein & Borun LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, IL 60606-6357

Re: Biomira Inc. v. Biomarin Pharmaceutical Inc.
Your Ref: 30610/10013
Our Ref: 342.057/09804335

Dear Richard:

Thank you for the update on the status of Biomarin's consideration of the settlement proposal.

We agree to the proposed thirty-day hold on the currently outstanding discovery response obligations. We are also prepared to go to the Board to extend the testimony periods as necessary; however, we are not inclined to extend the close of discovery beyond the current deadline.

In response to your letter of March 3, 2004, we have asked Biomira to confirm that no person who may be designated as a 30(b)(6) witness will be present in the United States before the discovery cut off date. If an appropriate witness does become available for an oral deposition before the close of discovery, we will let you know.

Very truly yours,


Katherine M. DuBray

KMD/bab

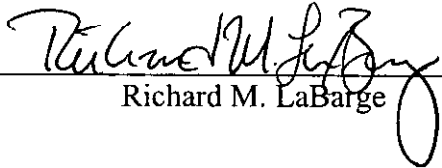
cc: Mark Ungerman

CERTIFICATE OF MAILING AND SERVICE

I certify that this document was filed with the TTAB and served on the opposer on March 23, 2004, by mailing copies by first-class mail, postage prepaid, to:

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
Box TTAB
2900 Crystal Drive
Arlington, VA 22202-3514

Mark E. Ungerman, Esq.
Katherine M. DuBray, Esq.
FULBRIGHT & JAWORSKI L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Fax no. (202) 662 4643


Richard M. LaBarge